

**Request for Reconsideration:**

Applicant acknowledges with appreciation the Examiner's courtesy in discussing the outstanding rejections and proposed amendments to the pending claims. In accordance with those discussions, Applicant is amending independent claims 1, 4, and 5 to describe the "pocket" more clearly and to state that the pocket is configured to receive "a majority" of the first and second cover surfaces. No new matter is added by the foregoing amendments, and these amendments are fully supported by the specification. E.g., Appl'n, Paras. [0022] and [0023]; **Fig. 4.** Applicant respectfully requests that the Examiner enter these amendments and that the Examiner reconsider the above-captioned patent application in view of the foregoing amendments and the following remarks.

Applicant believes that no fees are due as result of these amendments. However, in the event of any variance between the fees determined by Applicant and the fees determined by the U.S. Patent and Trademark Office, please charge such variance to the undersigned's Deposit Account No. 02-0375.

**Remarks:**

1. Rejections

Claims 1-5 and 8-10 are pending in this application. Applicant acknowledges with appreciation that the Examiner has withdrawn the rejections to claims 1 and 5 under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent No. 4,597,605 to Gilbert. Nevertheless, claims 1-3, 9, and 10 remain rejected under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent No. 4,273,380 to Silvestri. Further, claims 4, 5, and 8 stand rejected under 35 U.S.C. § 103(a), as allegedly rendered obvious by Silvestri in view of U.S. Patent No. 6,149,234 to Daniels. The Office Action has made these rejections **final**. Applicant respectfully traverses.

2. Anticipation Rejections

The Office Action rejects claims 1-3, 9, and 10 as allegedly anticipated by Silvestri. “A claim is anticipated if and only if each and every element of the claimed invention, as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP 2131 (citation omitted). The Office Action alleges that Silvestri discloses each and every element of Applicant’s invention as described in claims 1-3, 9, and 10. For the reasons set forth below and in view of the foregoing amendments, Applicant respectfully traverses.

The Office Action alleges that Silvestri describes a “non-elastic flap (30) attached to the second cover surface via tucks (32), wherein the non-elastic flap and the second cover surface forms [sic] a pocket therebetween (Fig. 1), and the pocket is adapted to be **disposed** over an upper portion of a chair (as shown in Figure 1). . . . A portion of said first and second surface the [sic] covers will inherently be retained within the pocket, upon folding of the cover into the pocket prior to inserting it within the tote bag.” Office Action, Page 2, Lines 10-22 (emphasis in original). Silvestri, however, does not describe “folding of the cover into the pocket prior to inserting it within the tote bag.” *Id.* In particular, Silvestri does not disclose (or suggest) “folding” any portion of the first or second cover surface “into the pocket prior to inserting it within the tote bag.” *Id.* Moreover, referring to Silvestri’s **Fig. 3**, no portion of the first cover surface is depicted within the pocket defined by tucks 32. Thus, Silvestri does not disclose, inherently or otherwise, each and every element of Applicant’s invention, as described in claim

1. Therefore, Applicant respectfully requests that the Examiner withdraw the anticipation rejection of claim 1 and of claims 2, 3, 9, and 10, which depend from claim 1, based on Silvestri.

3. Obviousness Rejections.

Claims 4, 5, and 8 stand rejected as allegedly rendered obvious by Silvestri in view of Daniels. In order for the Office Action to establish a prima facie case of obviousness, at least three criteria must be met. First, there must be some suggestion or motivation, either in the combined references or in the knowledge generally available to one of ordinary skill in the art, to combine the cited references in the manner proposed by the Office Action. Second, the prior art references must disclose or suggest all the claim limitations. Third, there must be a reasonable expectation of success. MPEP 2143. For the reasons set forth below, Applicant respectfully traverses these obviousness rejections.

As noted above, Applicant is amending claims 4 and 5 to describe a chair cover, “wherein said pocket is configured to receive a majority of said first cover surface and a majority of said second cover surface.” Silvestri describes tucks 32 as 1½ inches long. Silvestri, Column 1, Lines 63-66. A pocket defined by such tucks does not disclose or suggest that it is “configured to receive a majority of said first cover surface and a majority of said second cover surface.” Further, in view of the relative sizes of Silvestri’s tote and it’s pocket, as depicted in Silvestri’s **Fig. 3**, no suggestion or motivation is evident for modifying Silvestri’s beach accessory “to receive a majority of said first cover surface and a majority of said second cover surface” in it’s pocket. In addition, the Office Action relies on Daniels only to disclose or suggest Applicant’s “means for securing” (compare Appl’n, Claim 5) and “side pockets” (compare Appl’n, claim 4). Thus, Applicant maintains that neither Silvestri alone or in combination with Daniels discloses or suggests this limitations of the amended claims. Therefore, Applicant respectfully requests that the Examiner withdraw the obviousness rejections of claims 4 and 5 based on Silvestri in view of Daniels.

Claim 8 depends from claim 1. “If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” MPEP 2143.03 pg 2100-133 (8th ed., Rev. 2, May 2004)(citations omitted). Therefore, in view of the foregoing amendments and remarks concerning the anticipation rejection of claim 1, Applicant maintains that the obviousness rejection of claim 8 is untenable and respectfully requests that the Examiner withdraw the obviousness rejection of claim 8.

**Conclusion:**

Applicant respectfully submits that this application, as amended, is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that an interview with Applicant's representatives, either in person or by telephone, would expedite prosecution of this application, we would welcome such an opportunity.

Respectfully submitted,

BAKER BOTTS L.L.P.

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